

REMARKS AND ARGUMENTS

O.A. No. 1. Claim Rejection – 35 USC § 102(b)

The rejection of Claims 1 -11, 14 -16, 19, and 20 under 35 U.S.C. 102(b) as being anticipated by Cheldin (U.S. Patent No. 6,065,169) is respectfully traversed. Applicant respectfully submits that considering amended independent Claims 1, 16, and 20, Examiner has not established a *prima facie* case of anticipation.

MPEP 2131 and case law clearly state that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Considering the current claim amendments, it is respectfully submitted that Examiner has not provided a reasonable basis that Cheldin contains each element of the claims under consideration.

Amended Claim 1 encompasses:

A letter opener writing instrument device, comprising:

- i) a writing instrument having a case;
- ii) a pocket clip unit affixed to said writing instrument, and
- iii) a cutting element operatively attached to said device, said cutting element positioned between said writing instrument and said pocket clip unit providing for paper to be cut by the letter opener writing instrument and a stopper affixed to said writing instrument thereby limiting accessibility to said cutting element.

Amended Claim 16 encompasses:

A pocket clip cutting element unit for use with a writing instrument, comprising:

- i) a pocket clip arm, said pocket clip arm having a first end, a second end, and a first surface;
- ii) means for attaching said pocket clip arm to said writing instrument;
- v) a cutting element functionally attached to said first surface of said pocket clip arm proximate said first end of said pocket clip arm, and

iv) a stopper affixed to said writing instrument proximate to said second end of said pocket clip arm providing for limited accessibility to said cutting element.

wherein said pocket clip cutting element unit is positionable about said writing instrument providing for a letter opener writing instrument.

And amended Claim20 encompasses,

A letter opener writing instrument device, comprising:

- i) a writing instrument;
- ii) a pocket clip functionally affixed to said writing instrument; and
- iii) a cutting element operatively positioned between said writing instrument and said pocket clip therein providing means for paper to be cut, and
- v) a stopper operatively affixed to said writing instrument between said writing instrument and said pocket clip and between said cutting element and an end of said pocket clip not affixed to said writing instrument providing for limited accessibility to said cutting element.

Cheldin clearly does not teach a "letter opener writing device having a cutting element to which access is restricted by a stopper means."

On Page 3 of the Office Action, Examiner states in the third paragraph "... the device further comprises a stopper (where 20 is pointing) affixed to the writing instrument thereby limiting accessibility to the cutting element."

In fact, as can be clearly seen in all of the figures of Cheldin and as is stated in numerous places in the text, for example Col. 3, line 8, reference numeral 20 points to the letter opener itself. The instrument Cheldin teaches clearly does not include a stopper.

The "stopper" in Applicant's device provides a blunt barrier means to prevent unwanted material from reaching the cutting element, namely the material of a shirt pocket while providing sufficient space for a thin, stiff piece of paper, such as an envelope to be inserted past the stopper to reach the cutting means to be opened. Conversely, Cheldin's device, instead of teaching a barrier to the cutting means, teaches either an open, straight channel to the cutting means or a pathway that is made up of an angled avenue so as to provide a conduit that literally guides any material that

enters the area to the cutting means, whether that material be a paper envelope or the material of a shirt pocket. In short, Cheldin's device would facilitate the cutting of a shirt pocket were the device to be stored in a shirt pocket.

As a claim can be anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, and Cheldin does not teach a stopper barrier to the cutting means Cheldin can not be used as a valid reference to reject Claims 1 -11, 14 -16, 19, and 20. And as original Claim 2 recited a stopper, original Claim 2, with respect to Cheldin is patentable. Therefore, Applicant has combined the stopper as recited in original Claim 2 with the recitations of Claims 1, 16, and 20, and as Claims 2 – 11, 14, 15, and 19 all depend, either directly or indirectly, from Claims 1 or 16, Applicant respectfully submits that Claims 1 -11, 14 -16, 19, and 20 are patentable over Cheldin.

O.A. No. 2. Claim Rejection – 35 USC § 102(b)

The rejection of Claims 1- 20, under 35 U.S.C. 102(b) as being anticipated by Volk and Weiland (US Patent No. 471,283) is respectfully traversed and Applicant respectfully submits that considering amended independent Claims 1, 16, and 20, Examiner has not established a *prima facie* case of anticipation.

MPEP 2131 and case law clearly state that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Considering the current claim amendments, it is respectfully submitted that Examiner has not provided a reasonable basis that the teaching of Volk and Weiland contains each element of the claims under consideration.

Amended Claim 1 encompasses:

A letter opener writing instrument device, comprising:

- i) a writing instrument having a case;
- ii) a pocket clip unit affixed to said writing instrument, and

iii) a cutting element operatively attached to said device, said cutting element positioned between said writing instrument and said pocket clip unit providing for paper to be cut by the letter opener writing instrument and a stopper affixed to said writing instrument thereby limiting accessibility to said cutting element.

Amended Claim16 encompasses:

A pocket clip cutting element unit for use with a writing instrument, comprising:

- i) a pocket clip arm, said pocket clip arm having a first end, a second end, and a first surface;
- ii) means for attaching said pocket clip arm to said writing instrument;
- vi) a cutting element functionally attached to said first surface of said pocket clip arm proximate said first end of said pocket clip arm, and
- iv) a stopper affixed to said writing instrument proximate to said second end of said pocket clip arm providing for limited accessibility to said cutting element.

wherein said pocket clip cutting element unit is positionable about said writing instrument providing for a letter opener writing instrument.

And amended Claim20 encompasses,

A letter opener writing instrument device, comprising:

- i) a writing instrument;
- ii) a pocket clip functionally affixed to said writing instrument; and
- iii) a cutting element operatively positioned between said writing instrument and said pocket clip therein providing means for paper to be cut, and
- vi) a stopper operatively affixed to said writing instrument between said writing instrument and said pocket clip and between said cutting element and an end of said pocket clip not affixed to said writing instrument providing for limited accessibility to said cutting element.

Volk and Weiland clearly do not teach a "letter opener writing device having a cutting element to which access is restricted by a stopper means."

On Page 4 of the Office Action, Examiner states in the last paragraph on the page "... the device further comprises a stopper (3 is capable of being a stopper) affixed to the writing instrument thereby limiting accessibility to the cutting element."

In fact, as can be clearly seen in **FIGS. 2 – 4** of Volk and Weiland and as is stated in the text (for example in lines 52 -55) 3 is a stopper that stops what is to be cut after what is to be cut is slipped under and by the cutting means. That is, the stopper of Volk and Weiland is not designed to, nor is it capable of, limiting access of material to the cutting means. The instrument Volk and Weiland teaches clearly does not include a stopper as is recited by Applicant.

As was discussed above, the “stopper” in Applicant’s device provides a blunt barrier means to prevent material that is not meant to be cut from reaching the cutting element, namely the material of a shirt pocket, while providing sufficient space for a thin, stiff piece of paper, such as an envelope to be inserted past the stopper to reach the cutting means to be opened. Conversely, Volk and Weiland device, instead of teaching a barrier to the cutting means, teaches an open, straight channel to the cutting means and a “stopper” that assists the user in holding the paper to be cut in the proper position for it to be cut. In short, Volk and Weiland’s device could facilitate the cutting of a shirt pocket were the device to be stored in a shirt pocket.

As a claim can be anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, and as Volk and Weiland do not teach a stopper barrier to the cutting means Volk and Weiland can not be used as a valid reference to reject Claims 1, 16, and 20. And as original Claim 2 recited a stopper, original Claim 2, with respect to Cheldin is patentable. Therefore, Applicant has combined the stopper as recited in original Claim 2 with the recitations of Claims 1, 16, and 20, and as Claims 2 – 11, 14, 15, and 19 all depend, either directly or indirectly, from Claims 1 or 16, Applicant respectfully submits that Claims 1 - 20 are patentable over Volk and Weiland.

CONCLUSION

The Prior art made of record and not relied upon was considered.

Applicant believes that all of the claims of the Application are now in condition for allowance. Accordingly, favorable consideration of the present application is respectfully requested so that it may timely pass to issue.

Respectfully submitted,
Marko Stankovic, Applicant

/Patricia M. Costanzo/ Electronic Signature

Patricia M. Costanzo
Attorney for Applicant
Reg. No. 48,809

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P.O. Box 101
2960 Bowen Road
Elma, NY 14059
Telephone: 716-652-2380
Facsimile: 716-652-8868
law@patcostanzo.com